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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,675	03/20/2000	John Semen	AN-7075A	5583

7590 10/08/2003

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EXAMINER	
ANTHONY, JOSEPH DAVID	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/528,675	SEMEN, JOHN	
	Examiner	Art Unit	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-75* is/are pending in the application.

4a) Of the above claim(s) *1-35 and 42-75* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. I. Claims 1-5, 14, 16-19, 28, 30, and 70 drawn to a compound, classified in class 252, subclass 400.24.

II. Claims 6-13, 15, 20-27, 29, 31-35, 42-63, and 71-75 drawn to a compound in granular form, classified in class 252, subclass 400.23.

III. Claims 36-41, drawn to a process of making granules, classified in class 252, subclass 404.

IV. Claims 64-69, drawn to an additive system classified in class 252, subclass 407.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the granular product as claimed can be made by first melting the sterically hindered phenolic compound and then adding it to a friability reduction agent additive followed by forming granules and drying.

3. Inventions (I and II) and IV are distinct from each other because the product of Groups (I and II) does not require one or more of the additional polymer additive components of Group IV.

4. Inventions I and II are distinct from each other because the product of Group I can be in non granular form whereas the product of Group II must be in granular form.

5. Inventions III and (I and IV) are distinct from each other because the process of Group III makes a granular product unlike the non granular product of Group I and unlike the granular product of Group IV which require additional polymeric additives not required by Group III.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Philip M. Pippenger on 01/06/03 a provisional election was made with traverse to prosecute the invention of Group III,

claims 36-41. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-35, and 42-75 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. NOTE: THE EFFECTIVE FILING DATE FOR THE ELECTED CLAIMS IS DEEMED TO BE 09/22/1998 WHICH IS THE ACTUAL FILING DATE OF THE PARENT APPLICATION S.N. 09/158,588 NOW U.S. PATENT NUMBER 6,056,898.

12. Claims 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Gahan EP 0 403 431 or Gahan U.S. Patent Number 5,006,284.

Gahan EP and US, both teach making granules from sterically hindered phenols. The process comprises first synthesizing the sterically hindered phenols in the form of a

wet cake (reads on applicant's paste) containing 10% methanol (reads on applicant's friability reduction agent), followed by melting the wet cake (e.g. paste) and mixing it with aqueous methanol (reads on applicant's friability reduction agent) to form granules that are then dried, see the abstracts, and examples 1-2 of each reference.

13. Claims 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Marutani et al. U.S. Patent Number 5,117,040.

Marutani et al teach granular crystals with uniform grain size made from sterically hindered phenols, see abstract. Applicant's claims are deemed to be anticipated over Comparative example 1 wherein 100 g of sterically hindered phenol powder reaction product of example 2 is mixed with 113 g of methanol. This mixture is deemed to form a paste that is then melted to form a solution followed by crystallization and drying to form the crystal granular product.

14. Claims 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Yi U.S. Patent Number 4,357,449.

Yi teaches the production of polymer containing granules from polymer dispersions. The process comprises reslurring the filtered polymer product with Fotocol (contains 90% ethanol and CAO-5 a sterically hindered phenol), 1 part methyl zimate thermal stabilizer, 1 part Goodrite 3125 antioxidant - sterically hindered phenol?) Followed by the evaporation of the Fotocol and drying to form dried granules, see abstract and column 8, lines 20-33.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 36-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-23 of U.S. Patent No. 6,056,898. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are deemed to be a subset of the pending claims.

17. Claims 36-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,126,862. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are deemed to be a subset of the pending claims.

18. Claims 36-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 16-17 of U.S. Patent No. 6,126,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim is deemed to be a subset of the pending claims.

19. Claims 36-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-35, and 56-59 of copending Application No. 09/792,087. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the copending application are deemed to be a large subset of the pending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. The CONTINUATION DATA Section of pending application is confusing. Would applicant in his next response please clarify the exact continuation data sequence of the pending application. Especially how do Serial Number 09/203,941 now patent 6,126,862 and S.N. 09/204,121 now Patent 6,126,863 relate to the pending application.

Prior-Art Cited But Not Applied

21. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.

Joseph D. Anthony

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

10/1/03